

REMARKS

This amendment is submitted in reply to the Office Action dated January 7, 2008. Claims 11-37 currently stand rejected. Applicants have amended independent claims 33 and 37 to incorporate the Examiner's recommendation for overcoming the 101 and 112, first paragraph rejections. Claim 31 has also been amended. No new matter has been added by the amendment.

In light of the amendment and the remarks presented below, Applicants respectfully request reconsideration and allowance of all now-pending claims of the present application.

Claim Rejections - 35 USC §101 and 35 USC §112

Claims 33 and 37 currently stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter and under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner suggested Applicants amend claims 33 and 37 to recite "An apparatus comprising a server comprising a processor to". Applicants appreciate the Examiner's recommendation and have amended the claims accordingly. Thus, Applicants respectfully submit that the 101 and 112, first paragraph rejections are overcome.

Claim Rejections - 35 USC §103

Claims 11-37 currently stand rejected under 35 U.S.C. §103(a), as being unpatentable over Duse et al. (U.S. Patent No. 6,647,260, hereinafter "Duse") in view of Routtenberg et al. (U.S. Patent Application Publication No. 2002/0049717, hereinafter "Routtenberg").

Independent claim 11 recites, inter alia, requesting media content from a mobile station, temporarily saving the media content within the mobile station, and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content. Thus, according to an embodiment as recited in independent claim 11, the same media content that is requested is temporarily saved and a portion of the same media content, more specifically a portion that was itself specifically requested, is previewed. In other words the claimed invention requires that the

media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station.

The Office Action alleges that Dusse discloses content and related notifications, which combined are considered as "media content" specifically requested, and the related notifications are considered as the portion being previewed (col. 7, lines 42-62 and col. 8, lines 33-38). However, as the related notifications comprise terms, conditions and related information that are pushed to the mobile station, but are not specifically requested, the Office Action asserts that Routtenberg cures the admitted deficiency of Dusse by virtue of disclosure at paragraphs [0040] and [0041]. This analysis is respectfully traversed.

In this regard, the Office Action appears to assert that what is missing from Dusse is only a teaching or suggestion of previewing a specifically requested portion of media content. However, the deficiency of Dusse is more pronounced than this. In this regard, Dusse fails to teach or suggest more than just that the portion of the media content that is previewed was specifically requested. Rather, Dusse fails to teach or suggest temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11. In other words, Dusse fails to teach or suggest that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station in which the portion was specifically requested.

Routtenberg is directed to a digital content distribution method in which, according to a first embodiment, content is distributed to a content storage device where temporary access may be granted to a user. If the user selects to purchase the content, with a button push, the user may be enabled to permanently write the content to a self-contained removable digital storage medium such as a CD or DVD. In a second embodiment, an access device separate from a storage device may be given either temporary or permanent access based whether the user has purchased the content. Thus, in the first embodiment of Routtenberg, the media content is never stored in the mobile station, but instead is stored at an external self contained removable storage medium. Similarly, in the second embodiment of Routtenberg, the media content is not stored in

the mobile station at all, but is instead stored at a storage device that provides controlled access to the user. Therefore, Routtenberg fails to cure the above described deficiency of Dusse since Routtenberg never temporarily stores the media content in the mobile terminal. Thus, the media content of Routtenberg that is previewed is not content which was previously stored in the mobile station. Accordingly Routtenberg also fails to teach or suggest temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11, since Routtenberg fails to teach or suggest that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station in which the portion was specifically requested.

The Office Action asserts that the content storage device 106 of Routtenberg may be combined with the content access device 104 to be the same as the mobile station claimed. However, the content storage device 106 and the content access device 104 are described as being combinable in two specific manners, neither of which approximates the claimed mobile station. In the first manner, the content storage device 106 and the content access device 104 may be combined via a LAN, wireless DSL or cable modem connection (see paragraphs [0036] and [0038]). In the second manner, the content storage device 106 and the content access device 104 may be combined by a pluggable storage cradle (see paragraph [0036]). Thus, in both cases, Routtenberg fails to teach or suggest that the media content that was requested in the initial operation is temporarily saved within the mobile station and a portion of that saved media content is previewed at the mobile station in which the portion was specifically requested.

Independent claims 16, 31 and 36 include similar subject matter to that of independent claim 11 at least with respect to temporarily saving the media content within the mobile station and previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11. Accordingly, independent claims 16, 31 and 37 are patentable for at least the same reasons given above for independent claim 11.

Additionally, since the previewed portion of the media content of the claimed invention is a portion of media content that is not only specifically requested, but also stored within the mobile station, both Routtenberg and Dusse fail, either individually or in combination, to teach or suggest previewing at least a portion of the media content on the mobile station in which the previewed portion of the media content comprises a specifically requested portion of the media content as recited in independent claim 11. Independent claims 33-35 and 37 include similar recitations with regard to this feature and thus are patentable for at least the same reasons given above in relation to independent claim 11.

Despite the reasons given above for the patentability of the claimed invention, Applicants respectfully note that some of the independent claims include yet further novel and nonobvious features with respect to Dusse and Routtenberg. In this regard, independent claim 11 has also been amended to recite, *inter alia*, permanently saving the media content within the mobile station only when permission to save has been received from the server.

The Office Action alleges that the above recited feature is disclosed by Dusse at col. 7, lines 32-40 and col. 8, lines 35-47. However, col. 7, lines 32-40 of Dusse, only discloses saving content relating to device features and services that match requested features or services and there is no indication whatsoever in this passage of any requirement of receiving permission to save the content as recited in independent claim 11. The Office Action further asserts that col. 8, lines 35-47 of Dusse refers to user acceptance of the terms, conditions and related information, which the Office Action interprets as constituting "permission to save". However, as indicated above, independent claim 11 clearly recites that the permission to save within the mobile station is received from the server. Accordingly, Dusse fails to teach or suggest permanently saving the media content within the mobile station only when permission to save has been received from the server as recited in independent claim 11.

The Office Action also asserts that the feature above is disclosed by Routtenberg at paragraphs [0042] and [0048] by virtue of the server communicating successful billing to the user for purchased content files. However, previously asserted, in one embodiment of Routtenberg, the media content is never stored in the mobile station, but instead is stored at an external self contained removable storage medium. Similarly, in the other embodiment of

Routtenberg, the media content is not stored in the mobile station at all, but is instead stored at a storage device that provides controlled access to the user. The Office Action asserts that the writing of media content to the DSM of paragraph [0048] of Routtenberg corresponds to this feature. However, the DSM is described as, for example, a CD or DVD, which is in any case “removable” and “self-contained” in addition to being inter-operable with other devices. Thus, it is clear that the DSM is not usable for permanently saving content within the mobile station. Accordingly, Routtenberg also fails to teach or suggest permanently saving the media content within the mobile station only when permission to save has been received from the server as recited in independent claim 11.

Independent claims 16, 31 and 36 recite substantially similar subject matter to that of independent claim 11 with respect to permanently saving the media content within the mobile station only when permission to save has been received from the server and are therefore patentable for at least the same reasons given above for independent claim 11 with respect to this feature. Independent claims 33-35 and 36 each describe the transmission of a confirmation reply message to grant permission for the mobile station to permanently store the media content within the mobile station. Dusse is cited as disclosing this feature at col. 7, lines 32-40 and col. 8, lines 35-47. However, Dusse fails to teach or suggest this feature for the same reasons discussed above and Routtenberg fails to cure the deficiency of Dusse and is not cited as such. Thus, Routtenberg and Dusse, alone or in combination, also fail to teach or suggest this feature.

Independent claims 11, 16, 31 and 33-37 also describe sending or receiving a primitive with the mobile identification number of the mobile station. This feature is neither taught nor suggested in any of the cited references. In this regard, Dusse discloses sending a notification to a billing center at col. 6, lines 55-57, but *there is no indication that the notification includes the mobile identification number*. Furthermore, the Office Action incorrectly states that “Dusse teaches sending a primitive (notification) with MIN from said mobile station to said server” by virtue of the disclosure of the sending of the notification to the billing center. However, the billing center is clearly not the server as indicated in FIG. 4 of Dusse. Thus, Dusse clearly fails to teach or suggest sending or receiving a primitive with the mobile identification number of the mobile station as provided in independent claims 11, 16, 31 and 33-37.

The Office Action asserts that Routtenberg also discloses this feature at paragraph [0042] by virtue of updating the user's profile based on purchased, rental, rejection and non-selection information communicated through the network, which the Examiner asserts must have identification of the mobile station. Applicants disagree. In this regard, whether or not Routtenberg requires some form of identification of the user, there is no indication from Routtenberg as to how such identification is made. Furthermore, there is nothing to suggest that such identification be made using a mobile identification number of a mobile station. Thus, Routtenberg also fails to teach or suggest the above recited feature. Accordingly, the combination of Dusse and Routtenberg fails to teach or suggest sending or receiving a primitive with the mobile identification number of the mobile station as recited in the claimed invention. Furthermore, independent claim 11 further recites, receiving, at the mobile station, permission to save said media content in response to receipt of the primitive at said server, which is neither taught nor suggested in Dusse or Routtenberg or by the combination thereof.

For all the reasons above, Applicants respectfully submit that independent claims 11, 16, 31 and 33-37 are patentable over the Dusse and Routtenberg, alone or in combination. Claims 12-15, 17-30 and 32 depend directly or indirectly from independent claims 11, 16 and 31, respectively, and thus include all the recitations of their respective independent claims. Therefore, dependent claims 12-15, 17-30 and 32 are patentable for at least the reasons given above for independent claims 11, 16 and 31.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 11-37 are overcome.

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CONCLUSION

In view of the amendment and remarks submitted above, it is respectfully submitted that the present claims are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present invention.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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